

REMARKS

Claims 1-19 are pending in the present application. Claims 1, 6, 9, 10, 16, and 18 are amended. Claim 19 is new. Claims 1, 9, and 10 are independent claims. The Examiner is respectfully requested to reconsider the outstanding rejections in view of the following remarks.

Rejection Under 35 U.S.C. § 101

Claim 10 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that:

“The claim does not recite the codes are recorded on a computer readable medium and therefore, the claim is a computer per se which is directed to nonstatutory matter.” (Office Action at page 2)

Presumably, the Examiner intended to say that the claim is non-statutory because it is directed to a computer *program* per se.

Initially, Applicants submit that the Examiner’s rejection is improper. Before the above amendment, the preamble of claim 10 recited “[a] recording medium on which is recorded a program.” This phrase means the same thing as “a program, which is recorded on a recording medium.” Thus, contrary to the Examiner’s assertion, Applicants submit that the original preamble of claim 10 *did recite* a program recorded on a recording medium, and was thus statutory under § 101.

However, in an effort to expedite prosecution, claim 10 has been amended so that the preamble now recites “[a] computer readable medium encoded with a computer program.” This language is expressly approved in the MPEP. Particularly, MPEP § 2106.IV.B.1(a) states the following:

“...a claimed *computer-readable medium encoded with a computer program* is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer’s functionality to be realized, and *is thus statutory*.” (emphasis added)

As such, Applicants respectfully submit that claim 11 is statutory under § 101. Thus, the Examiner is respectfully requested to withdraw this rejection.

Rejections Under 35 U.S.C. § 103

Kondo Rejection

Claims 1, 2, 5-7, 9, 10, 13, 16, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,525,764 to Kondo et al. (hereafter “Kondo”). This rejection is respectfully traversed.

Initially, Applicants point out the following requirement for an obviousness-type rejection, as set forth in MPEP § 2143.03:

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Independent claims 1, 9, and 10 recite “when the image recorded on the original image medium is being moved, by moving the original medium, to the image reading position at which the image is to be registered, a moving state of the original medium is detected, and a dynamic image display mode is selected based on the detected moving state.” Applicants respectfully submit that Kondo fails to teach or suggest these features.

In the rejection, the Examiner relies on Kondo’s teachings in connection with the “previewing” process illustrated in Fig. 31 (see Office Action at pages 3-4). In describing this process, Kondo discloses the following in col. 3, lines 29-34:

“Fig. 31 is a flowchart showing an operational sequence of the film scanner 3000 and the external device 2810. Here, it is assumed that both the film scanner 3000 and the external device 2810 are already turned on, the firmware and the driver software are initiated, and *the film is already set at a predetermined position.*” (emphasis added)

As such, Kondo expressly discloses that this processing is performed after the film is set at the predetermined position, i.e., *after the image is registered*. Thus, when this processing is performed in Kondo’s system, the film is *not* being moved to the position at which the image is to be registered. Thus, the previewing processing of Fig. 31 in Kondo does not teach or suggest the detecting the moving state or selecting the image display mode when the image recorded on the original medium is being moved, *by moving the original medium*, to the image reading position, as required by independent claims 1, 9, and 10.

Furthermore, Applicants point out that in col. 2, lines 11-13, Kondo discloses that:

“...a sub-scanning motor, a stepping motor, [is] for moving the film holder 2802 in the sub-scanning direction.”

Kondo further discloses in col. 2, lines 35-61, that:

“...previewing is *designated by the user*. Upon designating previewing, ...the system controller 2811 issues an instruction to output timing signals...[and] the image is read line by line by exposing the CCD 2804 for a predetermined period of time while driving the sub-scanning motor 2813 *at a predetermined speed*” (emphasis added)

In the rejection, it is clear that the Examiner relies on Kondo’s previewing operation to teach the claimed dynamic display image mode (see Office Action at page 3). However, in the above-quoted passages, Kondo explicitly discloses that the previewing operation is selected or designated by the user. Thus, Kondo’s previewing mode is *not selected based on a detected moving state* of the film. In fact, Kondo’s sub-scanning motor causes the film to move *in*

response to the user designation. Since Kondo's film does not move until after the user designates the previewing mode, it is *impossible* for Kondo's system to select the previewing mode based on the detected moving state of the film.

Also, the above-quoted passages of Kondo clearly teach that the system controller 2811 *controls* the sub-scanning motor to move the film holder at a predetermined speed. Thus, Kondo's system *controls*, rather than *detects*, the moving state of the film.

Accordingly, it is clear that there is no teaching or suggestion in Kondo of either detecting a moving state of an original medium, or selecting a dynamic image display mode, when the image recorded on the original medium is being moved to the image reading position, as required by claims 1, 9, and 10.

At least for the reasons set forth above, it is respectfully submitted that independent claims 1, 9, and 10 are allowable over Kondo. Further, Applicants submit that claims 2, 5-7, 13, and 16 are allowable at least by virtue of their dependency on claims 1 and 9. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Kondo/Edgar Rejection

Claims 3, 4, 8, 11, 12, 14, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo in view of U.S. Patent No. 6,380,539 to Edgar (hereafter "Edgar"). Applicants respectfully submit that Edgar fails to remedy the deficiencies of Kondo set forth above in connection with independent claims 1 and 9. Accordingly, it is respectfully submitted that claims 3, 4, 8, 11, 12, 14, and 15 are allowable at least by virtue of their dependency on claims 1 and 9. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

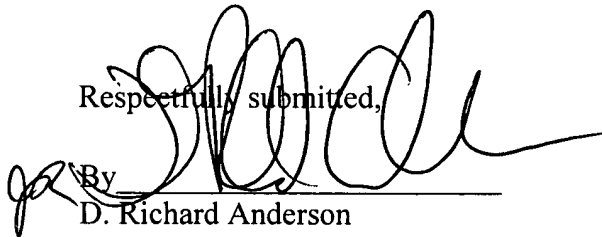
Conclusion

Entry of this Amendment After Final is respectfully requested. In view of the above amendments and remarks, Applicants believe the pending application is in condition for allowance.

However, should the Examiner believe that any outstanding matters remain in the pending application, the Examiner is requested to contact Jason Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the application in an effort to expedite prosecution.

Dated: January 23, 2006

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D. Anderson", is written over a horizontal line. To the left of the signature, the word "By" is printed.

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